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Adam Iredell Hayden

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MAGINOT, MOORE & BECK, LLP

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EXAMINER

SHAFFER, RICHARD R

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/811,338
Filing Date: March 26, 2004
Appellant(s): HAYDEN, ADAM IREDELL

JAMES D. WOOD
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 26th, 2008 appealing from the Office action mailed September 21st, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Caspari et al (US Patent 5,228,459).

Caspari et al disclose a system (**Figures 2 and 3**) comprising: a pin guide (**140**) with a bore (**142**) defining a first longitudinal axis; a support body (**42**) mountable to bone; an arm (**40**) extending from the support body (**42**); a first support member (**72**) and a second support member (**92**); a first block (**124**) with a dovetailed recess (**122**); a second block (**100**) with a dovetailed member (**121**); a third block (**66**); a fourth block (**60**); a first gross adjustment mechanism (engagement of **76** and **82**) for movement along a second longitudinal axis; a first fine adjustment mechanism comprising a thumbwheel gear (**132**) and rack gear (**104**) also for movement along the second longitudinal axis (when **100** is aligned with **82**); a second gross adjustment mechanism (engagement of **68** with **70**) for movement along a third longitudinal axis; a second fine adjustment mechanism (**78** engaging **72**) also for movement along a third longitudinal axis; a third adjustment mechanism (sliding motion of **46** within **48**); the longitudinal axes are not coincident since the first longitudinal axis is being taken as the center of

the bore (142) and the third longitudinal axis is taken as the center of the bore within 48; both allow movement “along” or parallel to the first and/or third longitudinal axes, however they are not overlapping but rather are parallel and therefore not coincident. In a partial second interpretation, it is also possible to remove stoppers (146 and 148) and therefore align the second block (100) parallel to the motion of 80 with 98 also providing for a third mechanism along a different direction than the first longitudinal axis.

(10) Response to Argument

The following arguments address applicant’s arguments to claims 30-49, specifically those of independent claims 30, 37 and 45 due to the common elements found in each claim being the issues on appeal.

1) Applicant initially contends that Caspari et al has been mischaracterized in that pin guide (140) with a bore (142) does not receive “bone engaging element” / “milling cutter” (138). It is noted that the examiner in the Office Action mailed on September 21st, 2007 never stated that the bone engaging element was element 138. Further, the claim only functionally recites the bone engaging element. The bore (142) as characterized is inherently capable of receiving a “bone engaging element” through which the element can be advanced in some manner (i.e. sliding it up and down through the bore). It matters not that the bore is meant for suction, as long as it’s capable of performing the claimed function without modification.

2) Applicant additionally asserts that Caspari et al do not disclose a third mechanism as claimed, specifically a mechanism for adjusting the guide along the first longitudinal axis. Applicant supports this assertion by stating: that “movement of a

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component along the axis defined by the suction tube port 142 does not bring the component into contact with a bone since the axis of the tube 48 is parallel to the bone (see, e.g., FIG. 3 of Caspari)."

This is not persuasive for numerous reasons. There is nothing preventing a bone from being placed "above" or within the path of the axis defined by bore 142 when moving it upward. It could be a surgeon's hand, the patient's hand, the patient could be bent forward, the device could be situated on a different area of the body, etc. There are countless possibilities in which the device could be orientated on the body to allow for a bone to be within the longitudinal axis defined by bore (142) with the third mechanism moving "a bone engaging element" towards the bone.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Richard R. Shaffer/

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R.R.S.
June 18th, 2008

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TQAS TC 3700